

USSN: 09/260,624  
Filing Date: March 1, 1999

### Remarks

Claims 1-6, 8-10, 12-13, 19, 22, 25 and 28 are pending after entry of this amendment. Claims 11, 15-18, 20-21, 23-24, and 26-27 have been canceled after entry of this amendment. Reconsideration of the pending Claims is respectfully requested in light of the amendments presented above and the remarks presented below.

### 35 U.S.C. § 112

Claims 1-6 and 8-28 stand rejected under 30 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the application was filed, had possession of the claimed invention. In particular, the Examiner asserts that the specification does not provide support for RAD51 antisense sequences other than SEQ ID NOS: 1 and 2. While the Applicants maintain their traversal of the basis for the Examiner's rejection, and expressly retain their right to pursue the previously claimed subject matter in one or more related applications, in the interest of expediting prosecution, the Claims now refer only to SEQ ID NOS: 1 and 2. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1-6, 8-13, and 15-28 stand rejected under 35 U.S.C. § 112, first paragraph as not having sufficient disclosure present in the specification to enable treatment of any whole organism as broadly claimed. Specifically, the Examiner maintains that there is insufficient teaching regarding the effective delivery of antisense molecules to the whole organism while specifically targeting certain tissues; regarding stability of the antisense molecule in vivo; and regarding dosage and toxicity. While the Applicants maintain their traversal of the basis for the Examiner's rejection, and expressly retain their right to pursue the previously claimed subject matter in one or more related applications, in the interest of expediting prosecution, the claims no longer refer to treatment of whole organisms. Accordingly, withdrawal of the rejection is respectfully requested.

USSN: 09/260,624

Filing Date: March 1, 1999

**35 U.S.C. § 102(a)**

Claims 1, 2, 4, 5, 8-12, and 14-28 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Ohnishi et al., Biochem. Biophys. Res. Comm. 245:319-324, 1998. Due to the broad nature of the present claim amendments, reconsideration of the patentability of the pending claims in view of the cited art is respectfully requested.

USSN: 09/260,624

Filing Date: March 1, 1999

### Conclusion

On the basis of the amendments and remarks presented herein, Applicants believe that this application is now in condition for immediate allowance. Applicants respectfully request that the Examiner pass this application to issue, and early notice of such is requested. This paper is filed under 37 C.F.R. section 1.34(a).

Respectfully submitted,  
DORSEY & WHITNEY LLP

Date:

<sup>02</sup>  
12/02/03

  
Richard F. Trecartin, Reg. No. 31,801

Four Embarcadero Center, Suite 3400  
San Francisco, California 94111-4187  
Telephone: (415) 781-1989  
1124994